

submitted that the amendments to the claims are fully supported by the specification. Accordingly, entry of the amendments is respectfully requested.

### **The Present Invention**

This reissue application is related to low volatility formulations of microencapsulated clomazone and processes for the preparation thereof. The unique formulations provide reduced volatility when compared with an emulsifiable concentrate formulation of clomazone.

### **The Pending Claims**

Claims 1-37 and 39-49 are pending in this reissue application. As background, the '780 patent contained fourteen claims as issued. Applicants amended claims 1-14, as issued, and added new claims 15-47 when this reissue application was filed. A Preliminary Amendment was filed on May 27, 1999, wherein Applicants requested cancellation of claims 22-47 and addition of new claims 48-64. However, after several conversations with the Examiner it was determined that the Preliminary Amendment was never matched to the file and, accordingly, the amendments requested therein were never made in the record. In an Amendment & Response to Office Action filed on February 22, 2001, Applicants requested that the Preliminary Amendment *not* be entered into the record in order to expedite prosecution; instead, Applicants requested the entry of claims 48 and 49. Claims 1-37 and 39-49 relate to novel and unobvious low volatility formulations of microencapsulated clomazone and processes for the preparation thereof.

**Declaration**

At page 2 of the Office Action, claims 1-47 stand rejected under 35 U.S.C. § 251 for allegedly being based upon a defective declaration. Specifically, the Office Action contends that the reissue oath/declaration filed on February 22, 2001, is defective because it fails to identify at least one specific error which is relied upon to support the reissue application. Applicants respectfully traverse the rejection on the grounds that the reissue oath/declaration filed on February 19, 2001, identifies at least one specific error which is relied upon to support the reissue application. Specifically, the reissue oath/declaration states at page 1, last paragraph, the following:

“The reissue application is being filed because patentee claims less than the patentee had a right to claim.”

It is clear from this passage in the reissue oath/declaration filed on February 19, 2001, that Applicants have identified at least one specific error which is relied upon to support the reissue application. Accordingly, Applicants respectfully request withdrawal of this rejection.

**Rejections under 35 U.S.C. §112, first and second paragraphs**

At pages 2 and 3 of the Office Action, claims 1, 8, 15, 16, 19, 22-42, 48 and 49 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabling. Specifically, the Office Action contends that deletion of the antifoam agent is not enabled by the present disclosure because of the Examiner's view that such is critical to the claims.

Applicants respectively traverse this rejection and request full reconsideration thereof.

First, it is submitted that the Examiner is misreading the specification. More specifically, it is recognized that the specification at col. 1, lines 56-60 discloses a process embodiment of the

invention containing an antifoam agent. However, this embodiment does not state that the antifoam agent MUST ALWAYS be present – it merely states that it is in that embodiment. It is also recognized that the specification discloses at col. 2, lines 16-21 that the aqueous phase will “ordinarily” contain an antifoam agent, but this again does not mean that it MUST ALWAYS contain an antifoam agent – on the contrary, it clearly and unambiguously infers that the antifoam agent does NOT have to be present in all cases. Finally, it is absolutely clear from claim 1 as issued that the antifoam agent can be optionally used in this invention. This is bolstered by the fact that claim 1, as filed in the original application, also stated that the antifoam agent was optional. The preponderance of the evidence, e.g., original claim 1 and col. 2, lines 16-21, make it clear that the antifoam agent is not stated by Applicants to be a “critical” or “required” feature of this invention.

Second, the Examiner has failed to present any evidence why one skilled in the art would not be able to make and use the present invention when an antifoam agent is not used.

MPEP § 2164.04 states the following:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention...References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required...However, specific technical reasons are always required.

However, to date, no such technical reasons have been provided by the Examiner.

Because one skilled in the art would be able to make and use the present invention without undue experimentation and the Examiner has not provided any evidence or technical reasons to the contrary, Applicants respectfully request that this rejection be withdrawn.

At page 4 of the Office Action, claims 1, 8, 15-17, and 19-49 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabling. The Office Action contends on page 4 that polyvinyl alcohol (PVA) is "critical" to the practice of the invention and its absence from the claims is not enabled by the disclosure.

Applicants respectfully traverse the rejection and request full reconsideration thereof.

Contrary to the Examiner's position, the specification clearly and unambiguously states that PVA is not critical for the invention to function as intended. See, e.g., column 1, line 58, stating that the formulations of the present invention may contain an emulsifier which is "preferably, a partially hydrolyzed polyvinyl alcohol" and column 2, lines 17 and 18, which states "one or more emulsifiers, e.g., polyvinyl alcohol" that may be used in the present invention. Features that are merely preferred are not critical. See *In re Goffe*, 542 F.2d 564, 567, 191 U.S.P.Q. 429, 431 (CCPA 1976). Similarly, MPEP §2164.08(c) states the following:

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Here, no such limiting prior art has been provided by the Examiner. The testing in Tables 5a and 7 merely evidence a particular embodiment that did not work, but Applicant is not required to list all operable embodiments. As stated in *In re Goffe*:

To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines

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specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

See 542 F.2d at 567.

Finally, again, the Examiner has failed to provide any evidence that this area of technology is complex, unpredictable, etc. such that one skilled in the art would not know what other emulsifiers would work.

In view of the foregoing, it is respectfully submitted that the present claims are fully enabled by the specification and the knowledge and skill in the art and that the Examiner has failed to carry the burden of showing otherwise. Accordingly, withdrawal of this rejection is respectfully requested.

At page 4 of the Office Action, claims 37-40, 48 and 49 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabling. Similar to the rejection set forth above, the Office Action contends on page 4 that the hydrocarbon solvent is critical and essential to the practice of the invention and its absence from the claims is not enabled by the disclosure.

Applicants respectfully traverse the rejection and request full reconsideration thereof.

That is, Applicants respectfully submit that the specification makes it clear that the use of a hydrocarbon solvent is not critical for the invention to function as intended. See, e.g., col. 1, line 62, which states that the present invention may be prepared "with or without a hydrocarbon solvent". The Examiner has failed to provide any evidence or reasoning as to why this is critical or why one skilled in the art would not be able to make and use the invention without the hydrocarbon solvent without undue experimentation.

For the reasons set forth above, this rejection is improper and withdrawal is respectfully requested.

At page 4 of the Office Action, claim 37 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabling for failure to recite that the shell is a polyurea shell.

Without acceding to the correctness of that contention, Applicants have amended claim 37 to indicate that the shell is a polyurea shell. Withdrawal of the rejection is respectfully requested.

The Office Action asserts on page 5 that page 3 of Applicants' response to the first rejection in the parent application supports the conclusion that the claims must be amended to specify microencapsulated clomazone in a polyurea shell comprising the hydrocarbon solvent, the antifoam agent and the PVA emulsifier. Applicants respectfully submit that the Examiner has misinterpreted Applicants statement on page 3 of the response to the first rejection in the parent application. Applicants respectfully submit that the statement referred to by the Examiner was made to distinguish the present invention from the prior art and overcome an obvious rejection. Nothing about this statement means that the PVA, antifoam agent or hydrocarbon solvent are individually or collectively "critical" or "required".

At page 5 of the Office Action, claims 1, 8, 15-17 and 19-49 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting "essential" elements. Similar to the rejections set forth above, the Office Action contends on page 5 that the PVA and antifoam agent are omitted "essential" elements, such omission amounting to a gap between the elements.

Applicants respectfully traverse the rejection and reconsideration is respectfully requested. That is, Applicants have herein referred to passages in the specification relating to PVA and the antifoam agent showing that such were not indicated to be "critical" or "required" elements of the invention. Accordingly, withdrawal of this rejection is respectfully requested.

At page 6 of the Office Action, claims 2, 4, 6, and 28 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Office Action contends that: i) there is no antecedent basis in claims 2, 4, and 6 for "the antifoam agent" and (ii) claim 28 is missing the word "has".

Applicants have amended the claims herein to address both concerns. Withdrawal of this rejection is respectfully requested.

Applicants are appreciative of the Examiner's suggestion at page 6 regarding how to clarify the subject matter claimed in claim 1, part "e", but have decided not to make such an amendment. Further, Applicants have amended claims 37, 39 and 40 as suggested by the Examiner at page 6.

### **Conclusion**

In view of the amendments and remarks presented above, Applicants respectfully submit that the pending claims are in condition for allowance. Early, favorable action is earnestly requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§ 1.16 and 1.17 that may be required in filing this paper to Deposit Account No. 06-1440.

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If, in the opinion of the Examiner, a telephone conference with the undersigned would facilitate prosecution of this patent application, the Examiner's call would be welcomed.

Respectfully submitted,

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